

Application No. 10/598,877
Amendment Dated 12/7/2009
Reply to Office Action of 10/07/2009

REMARKS/ARGUMENTS

By this Amendment, claims 3, 18, 20 and 21 are amended. Claims 1-21 are pending.

Citations to the Specification are directed to U.S. Patent Application Publication No. 2008/0242858. Support for the amendments to the claims can be found throughout the Specification as filed, and specifically: support for the amendment to claim 21 can be found in ¶[0047].

Entry of this Amendment is proper under 37 C.F.R. §1.116 because the Amendment: (a) places the application into condition for allowance (for reasons discussed herein), (b) does not raise any new issues requiring further search and/or consideration (because the Amendment is directed to subject matter previously considered during prosecution), (c) does not present any additional claims without canceling a corresponding number of finally rejected claims, and (d) places the application into better form for appeal, should an appeal be necessary. Applicants respectfully request entry of the Amendment.

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

Rejection under 35 USC 112 second paragraph

Claims 3, 18, and 20 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is respectfully traversed.

In Hybritech Inc. v. Monoclonal Antibodies, Inc., 231 USPQ. 81, 94 (CAFC 1986) it was stated:

". . if the claims read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more." (citing Shatterproof Glass Corp. v. Libbey Owens Ford. Co. 225 USPQ 634, 641 (CAFC 1985)).

Thus, whether a claim is in compliance with the second paragraph of § 112 requires a determination of whether those skilled in the art would understand what is claimed when the claim is read in light of the specification.

The Examiner sets forth that claim 3 is ambiguous, allegedly because it might be further narrowing the step (a) temperature, or it might refer to another step, e.g. the hydrolysis reaction

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of step (c), and notes claim 11. Without acquiescing to the propriety of the Examiner's rejection, and solely in an effort to advance prosecution, claim 3 has been amended to add the limitation "in claim (a)".

The Examiner rejects claims 18 and 20 as allegedly being indefinite. The Examiner argues that Applicant appears to be reading claim 18 as limiting only the acid of step d, but it has no such claim language, and that claim 20 does the exact same thing. It limits both acids to aqueous HCL. The Examiner sets forth that this can be fixed by adding "in step (e)" to claim 20, and "in step (d)" to claim 18.

Without acquiescing to the propriety of the Examiner's rejection, and solely in an effort to advance prosecution, claim 18 has been amended to add the limitation "in step (d)", and claim 20 has been amended to ad the limitation "in step (e)".

Thus, one skilled in the art would understand what is claimed when the claim is read in light of the specification. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Claim Objections

Claim 21 stands objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. The Examiner sets forth that Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The Examiner sets forth that the claim as written does not limit claim 1, as claim 1 does not provide for cefixime in the first place.

However, claim 1 is directed to a process of preparing cefixime, and there is a crystallization step in step (e). Claim 21, which depends from claim 1, recites that the cefixime which is crystallized in step (e) is a cefixime trihydrate of formula Ia. Claim 21 thus further limits claim 1, and therefore, reconsideration and withdrawal of the objection is respectfully requested.

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For at least the reasons set forth above, it is respectfully submitted that the above-identified application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are respectfully requested.

Should the Examiner believe that anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

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